

## **REMARKS**

Claims 22-41 are pending and stand rejected. The prior response had two claims numbered as claim 33. The Applicant has canceled the second claim numbered 33 and represented it as new claim 42. The Applicant respectfully requests reconsideration in light of the following.

### **I. Examiner Interview**

The Applicant respectfully thanks Examiner Wong and Supervisory Examiner Hoteling for taking the time to conduct a teleconference on December 9, 2009. During the teleconference, the Applicant explained its position in regard to the signal button aspect of claim 22 and why the Applicant believes Thomas does not teach aspects. Furthermore, Examiner Wong further explained his position in regard to the single wagering unit aspect of claim 22 and identified language in Thomas purported to support his position. Though no agreement was reached, both sides concluded further study of Thomas in regard to such aspects was warranted.

### **II. Claim Rejections Under 35 U.S.C. § 102 (Thomas)**

The Office Action rejected claims 22-23, 26-27, 31-37, and 39 under 35 U.S.C. § 102(e) as being anticipated by US Pub. 2004/0072607 to Thomas et al., hereinafter

"Thomas." Applicant respectfully requests the present rejections of claims 22-23, 26-27, 31-37, and 39 be withdrawn for reasons presented below.

**A. Claims 22, 23, 31, and 32**

Each of claims 22, 23, 31, and 32 is directed to a method comprising the steps of initiating a play of a first game in response to determining that a game play button has been actuated, and initiating a play of a second game in response to determining that said game play button has been actuated. Thus, each of claims 22, 23, 31, and 32 is directed to a method that initiates the play of two games using a common game play button. In one illustrated embodiment, the common game play button is the start/spin button 22 shown in Figure 3 of the present application.

As shown in Figure 3 of the present application, the button 22 is marked with the word SPIN for the first game, and is also marked with the words START FEATURE for the second game (the feature game). That is, a common game play button is used for both games in the illustrated embodiment.

Applicant respectfully submits that Thomas does not teach a method of initiating a play of a first game in response to determining that a game play button has been actuated, and initiating a play of a second game in response to determining that the same game play button has been actuated. The Office Action appears to rely upon Thomas paragraph 27 for a teaching of initiating a play of a first game in response to

determining that a button has been actuated and to rely upon Thomas paragraph 50 for a teaching of initiating a play of a second game in response to determining that a button has been actuated.

Applicant respectfully submits that Thomas and paragraphs 27 and 50 in particular do not teach that the button used to initiate the game of paragraph 27 is the same button used to initiate the game of paragraph 50. In particular, paragraph 27 indicates that "[a]fter activation of the paylines, the reels 14, 16, 18 are set in motion by either pulling a lever 20 or depressing a push button (not shown) on the slot machine 10." However, paragraph 50 states that "an animated 'hand' pointer scrolls across the grid and window selection is accomplished by the player depressing a designated 'select' button when the hand is pointing to a desired selection." Accordingly, paragraph 27 merely indicates that a push button may be depressed to set the reels 14, 16, 18 in motion, but does not otherwise identify the button. On the other hand, paragraph 50 states a "select" button may be depressed to make a window selection. Thus, paragraphs 27 and 50 do not explicitly teach that the buttons are the same. Moreover, Applicant respectfully points out that Thomas does not inherently disclose that the buttons of paragraphs 27 and 50 are the same. As noted at MPEP 2112(IV):

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir.

1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted)

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)

The Office Action has not demonstrated that the button of paragraph 27 and the button of paragraph 50 "must" be the same button. As such, Thomas does not explicitly and/or inherently disclose initiating a play of a first game in response to determining that a game play button has been actuated and initiating a play of a second game in response to determining that said game play button has been actuated. Accordingly, Thomas does not anticipate claims 22, 23, 31, and 32. Applicant respectfully requests the withdrawal of the present rejection of claims 22, 23, 31, and 32.

**B. Claims 26, 27, and 33**

Each of claims 26, 27, and 33 is directed to a gaming machine comprising a game play button and an electronic controller to initiate a play of a first game in response to determining that the game play button has been actuated and to initiate a play of a second game in response to determining that the game play button has been actuated. As explained above, Thomas does not explicitly and/or inherently teach a common game play button to initiate a play of a first game and to initiate a play of a second game. Thus, Thomas does not anticipate claims 26, 27, and 33. Withdrawal of the present rejection of claims 26, 27, and 33 is earnestly solicited.

**C. Claims 34-37 and 39**

Each of claims 34-37 and 39 is directed to a gaming machine comprising, among other things, a button associated with a base game and a bonus feature game; and a controller to initiate the base game in response to actuation of the button and to initiate the bonus feature game in response to actuation of the button. As explained above, Thomas does not explicitly and/or inherently teach a common button to initiate a play of a base game and to initiate a play of a bonus feature game. Thus, Thomas does not anticipate claims 34-37 and 39. Withdrawal of the present rejection of claims 34-37 and 39 is earnestly solicited.

### **III. Claim Rejections Under 35 U.S.C. § 103 (Thomas/Vancura)**

The Office Action rejected claims 24-25, 28-30, 38, and 41 under 35 U.S.C. § 103(a) as being unpatentable over Thomas in further view of US Pub. 2004/0219963 to Vancura, hereinafter "Vancura." Each of claims 24-25, 28-30, 38, and 41 includes one of claims 22, 26, and 34 as a base claim and is therefore allowable for at least the reasons discussed above in regard to the respective base claim. Withdrawal of the present rejection is earnestly requested.

### **IV. Claim 40**

The Office Action Summary indicates claim 40 is rejected. However, the Office Action does not identify art or provide reasons for rejecting claim 40. As such, claim 40 has yet to receive substantive examination. Assuming the Office Action meant to reject claim 40, the Applicant respectfully requests the Examiner to identify the art under which claim 40 is rejected and to provide a detailed explanation as to why such art renders claim 40 unpatentable.

### **V. Final Matters**

As a final matter, the Office Action makes a number of statements regarding: the pending claims; the Thomas and Vancura references; 35 U.S.C. § 102; 35 U.S.C. § 103; and the state of the art that are moot in light of the previous amendments and/or

remarks. Thus, the Applicant has not addressed all of such statements at this time. The Applicant neither agrees nor disagrees with such statements and explicitly reserves the right to challenge such statements in the future should the need arise.

**SUMMARY**

In summary, the Applicant believes that the pending claims are in condition for allowance and courteously solicits a Notice of Allowability with respect to all pending claims. If the Examiner disagrees or has questions regarding this submission, the Applicant requests an Examiner Interview, in particular prior to the issuance of any Office Action. The Examiner may contact the undersigned at 312-238-8600.

The Commissioner is hereby authorized to charge additional fees or credit overpayments to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

Dated: December 18, 2009

Respectfully submitted,

/Jeffrey B. Huter/

Jeffrey B. Huter  
Reg. No. 41,086

McAndrews, Held & Malloy, Ltd.  
500 West Madison Street, 34th Floor  
Chicago, Illinois 60661  
Telephone: (312) 238-8600  
Facsimile: (312) 775-8100